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EXAMINER

SHAH, MILAP

ART UNIT

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3714

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/809,329	Applicant(s) LEVITAN ET AL.	
	Examiner Milap Shah	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the amendment received on January 18, 2008. The Examiner acknowledges that claims 1-4 & 12 were amended, no claims were canceled, and claims 13-19 were added. Therefore, claims 1-19 are currently pending.

Drawings

The replacement drawings were received on January 18, 2005. These drawings are accepted.

Claim Objections

Claim 1 is objected to because of the following informalities: Claim 1 appears to include some minor punctuation issues. There appears to be multiple "and" conjunctions in the claim and an "and" is missing immediately before the last limitation of the claim. Thus, the Examiner merely requests the Applicant to carefully examine the claim for proper punctuation. Also, the Applicant may find it beneficial to use semicolons between each separate limitation. Appropriate correction is required.

Claim 4 is objected to because of the following informalities: Claim 4 recites "said web browser", however, the "web browser" limitation was deleted from claim 3 in the most recent claim amendments, thus, "said web browser" lacks antecedent basis in claim 4.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, & 11 are rejected under 35 U.S.C. 102(b) as being anticipated by “NOKIA: Introduction to Mobile Game Development”, Forum Nokia, ‘Online’, January 2003 XP02291333 [as cited by the Applicant in the IDS filed November 26, 2004] (hereafter “Nokia”).

Claim 1: Nokia teaches the same invention including a personal portable device (i.e. mobile or cellular telephone) to be carried by a user and having a primary practical function (i.e. to make telephone calls) and a secondary personal entertainment function (i.e. to play games), the primary practical function including the capability to communicate over a wireless communication network with a separate computer (see "1. Introduction", page 1), the secondary personal entertainment function includes a series of downloadable games downloaded to the personal portable device using the communication capability of the primary practical function to form a wireless connection with a game server computer and have the game server computer download at least one additional game, the at least one additional game including as part thereof a tracking arrangement for tracking usage information with respect to the play of the at least one game and to communicate the use information to the game server computer over the wireless communication network when the personal portable device is in communication with the game server computer (see at least “2. How Games Are Implemented for Mobile Phones” at pages 2-3, "3.6 Deployment" at page 3, “7.2 Multiplayer Soloplay Games” at page 7, and "9.1. Application Sale" at page 9), the at least one game being operable to receive from the game server computer when the personal portable device is in communication with the game server collective results for said at least one game of other personal portable devices including collective high score ranking information (see at least “7.2. Multiplayer Soloplay Games” at page 7, where Nokia explicitly discloses the game server providing each of multiple players score or ranking information at the conclusion of a game, including what each player scored and the high scores of the game).

Claim 3: Clearly the entire Nokia disclosure refers to a mobile or cellular telephone having gaming capabilities, thus, the personal portable device is at least a cell phone (see "1. Introduction" at page 1).

Claim 11: Nokia discloses the personal portable device is a mobile or cellular telephone which may be interpreted as a personal data assistant as a mobile telephone assists in personal data (i.e. address book). Nokia further discloses the personal data assistant is linked with a computer which connects with the game server computer and allows communication of the personal data assistant with the game server (i.e. the cell phone is connected wirelessly to the cell phone provider's network including multiple servers, where through the network of servers and computers, the cell phone or personal data assistant is connected to the specific computer(s) operating as a game server).

Claims 1, 3-7, 11, 18, & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Emmerson (U.S. Patent Application Publication No. 2002/0103019).

Claim 1: Emmerson teaches the same invention including a personal portable device (i.e. mobile or cellular telephone – paragraph 0002) to be carried by a user and having a primary practical function (i.e. to make telephone calls) and a secondary personal entertainment function (i.e. to play games), the primary practical function including the capability to communicate over a wireless communication network with a separate computer (figure 2 & paragraph 0022), the secondary personal entertainment function includes a series of downloadable games downloaded to the personal portable device using the communication capability of the primary practical function to form a wireless connection with a game server computer and have the game server computer download at least one additional game, the at least one additional game including as part thereof a tracking arrangement for tracking usage information with respect to the play of the at least one game and to communicate the use information to the game server computer over the wireless

communication network when the personal portable device is in communication with the game server computer (see at least paragraphs 0022-0026, 0032-0033, & 0040-0041), the at least one game being operable to receive from the game server computer when the personal portable device is in communication with the game server collective results for said at least one game of other personal portable devices including collective high score ranking information (paragraphs 0040-0041, where Emmerson discloses that game server receives scoring information from each of a plurality of players, updates a league table with the standings of each player and informs the player where he stands in the league table, thus collective use information is obtained).

Claim 3: Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

Claim 4: Emmerson discloses a web browser application as being present on the mobile phone (paragraph 0024). Emmerson also discloses a subscription/registration process, whereby a player must have initially subscribed or registered to the game server to participate in multiplayer games through the game server. Thus, upon connection to the game server, the server performs an authentication process to determine if the player has previously subscribed and has access to the game server. If yes, access is granted and the game selection process continues. However, if no subscription is determined, the player is denied access and alternatively provided with instructions on how to register/subscribe and pay the necessary fees to access the game server. Further, for purposes of filling out a registration or subscription form, the browser on the mobile phone must be utilized, thus, Emmerson discloses allowing a user to initially register with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026).

Claim 5: Emmerson discloses that at block 260 (figure 4), the server downloads an updated league table with collective use information to the player's mobile phone, where such information is selectively displayable when the player wishes to view his standings in the league table (paragraph 0041).

Claim 6: Clearly there must be a display function to use the mobile phone's LCD (paragraph 0002) to display game information such as collective use information, amongst other information.

Claim 7: Emmerson discloses a series of games being downloaded to the mobile phone (paragraph 0041, where Emmerson discloses upon a player submitting a new game outcome or result, the game server could send out the next fixture or level in the competition, where the competition has multiple games, fixtures, levels, or the like, thereby being a series of downloaded games).

Claim 11: Emmerson discloses the personal portable device is a mobile or cellular telephone, as discussed above, which may be interpreted as a personal data assistant as a mobile phone assists in personal data (i.e. address book). Emmerson discloses the personal data assistant is connected to operator server (figure 2[server 42]), which relays communication to the game server (figure 2[server 31]) connected to the operator server.

Claim 18: Emmerson discloses the at least one game is operable in a tournament for fame mode where the game server computer receives and processes game result from a group of personal portable devices (paragraph 0008).

Claim 19: See the rejection of claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter

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as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8-10, & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson, as applied to claims 1, 3-7, 11, 18, & 19, where applicable, further in view of Acres (U.S. Patent Application Publication No. 2001/0034643).

Claims 2, 8, 9, & 12: Emmerson discloses the invention substantially as claimed except for explicitly disclosing a sweepstakes mode, the sweepstakes mode being based on various gaming activities such as an entry for each time at least one game is played and communicated to a game server during a predetermined time period, an entry for registration and the number of times the eligible games are played and communicated to the game server, or an entry each time a game in the sweepstakes mode is simply played. Regardless of such a deficiency in Emmerson, those of ordinary skill in the art would have found such a sweepstakes mode to be a notoriously well known option in the gaming arts for implementation in a variety of gaming applications. Specifically, the Examiner submits that Acres explicitly teaches a sweepstakes mode of gaming in which an advertisement system may provide an incentive for a user to play a game and view advertisements by offering rewards such as entries to sweepstakes based on a variety of gaming activities, such as a user who completes a game within a certain period of time, a user who has one of the 10 highest scores, or a user who has one of the longest winning streaks may receive this additional reward (paragraph 0018). While Acres is directed to casino gaming using gaming terminals (i.e. slot machines or the like), the teachings of Acres appear applicable in a variety of different gaming applications (i.e. mobile gaming, computer gaming, console gaming, etc.). Given Acres teachings, one skilled in the art would have found it obvious to implement a sweepstakes mode in the mobile games played within the Emmerson invention to benefit both the players (i.e. providing additional ways to win – a sweepstakes drawing) and the gaming hosts (i.e. additional revenue from advertising sponsors). The concept of advertising and providing additional awards, such as sweepstakes entries or raffle tickets,

has been notoriously well known in the art for some time, and upon Applicant's request the Examiner will submit numerous additional prior art literature that discusses these types of marketing techniques to attract more players and generate higher revenues for gaming hosts. Acres, as seen in figure 1, has four portions of the game screen dedicated to advertisements, and as is known in the marketing industry, advertisements are not cheap, thus clearly the gaming hosts are generating a plentiful revenue stream from these advertisements. Consequently, the gaming hosts are able to offer a wide variety of additional bonuses or rewards to players for their loyalty and game play. Therefore, for at least the reasons provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Emmerson to implement a sweepstakes "mode" of the mobile games applications. Further, it would have been obvious to base the individual entries off a plethora of possible measurable gaming activities including those discussed above, for at least the reason that if Acres provides sweepstakes entries for such activities as obtaining a high score, it would be art recognized equivalents to base sweepstakes off additional obvious variants - basically, it appears any gaming activities that could be monitored or measured in some way could be used by a game designer to implement the known sweepstakes mode based on said gaming activities.

Claim 10: The combination of Emmerson & Acres teaches an advertisements server (Acres, abstract), thus, when implementing the teachings of Acres into Emmerson, it would have been obvious to display advertisements obtained from the advertisement server when the device is in communication with the game server computer (i.e. where the advertisement server may be implemented as part of the game server, or alternatively where it has been held in court that a mere combination of elements of the prior art is not a reason for patentability – in this case, combining the advertisements server and the game server of the prior art to form a single server performing both tasks).

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Claims 13 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson, as applied to claims 1, 3-7, 11, 18 & 19, where applicable.

Claim 13: Emmerson discloses the invention substantially as claimed except for explicitly disclosing two separate high scores lists for collective users, one being local to each particular cell phone (local mode) where any user can use any name or alias for the high scores list and a second one being remote on the gaming server, which requires subscription or registration (registered mode).

Regardless of this deficiency, the Examiner submits that a local mode high scores list is notoriously well known in the art. In general gaming, such as via mobile devices, consoles, arcade games, or the like have been known for many decades to save a local high scores list, simply for competition amongst local persons (i.e. friends and family). Emmerson discloses a newer modern age of competition based on high scores in a game, whereby instead of playing simply with friends of family local to the game device, a player enjoys the excitement of playing globally with anyone that has the same game. Thus, the Examiner submits that the local mode is a well known mode and Emmerson discloses the registered mode, as Emmerson's game requires subscription or registration to post high scores, as described earlier. One skilled in the art would be motivated to modify Emmerson to provide both modes of game play, if such would not have already been implemented (i.e. it's the Examiner's position that such would be implemented in Emmerson's games, however, Emmerson makes no disclosure of such a local mode simply because of how well known a local high scores list is in the gaming arts). Those skilled would be motivated to allow the players in Emmerson's games to practice certain games used in tournaments, locally, without having to waste bandwidth and time submitting scores that were mediocre at best. Additionally, other friends and family would be able to play said games on the player's device without having to register new identities with the game server. Many advantages can be seen from having both modes of game play on cell phone for mobile gaming. Therefore, it would have been prima facie obvious to one of

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ordinary skill in the art at the time the invention was made to modify Emmerson with a local mode, where players of any identity could save a collective high scores list without submitting anything to a game server, and alternatively a registered mode in which players who have registered or subscribed have access to submit their scores to online leader boards or league tables for at least the reasons provided above.

Claim 17: As previously discussed throughout this action, Emmerson discloses a registration or subscription feature to allow a player to register to play on a game server for participation in game tournaments operated on the game server (i.e. competitions as disclosed by Emmerson), where games are played on the personal portable devices and game results are communicated to the game server computer when connected thereto (*id.*)

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson, as applied to claims 13 & 17, where applicable, in view of Acres.

Claims 14 & 16: It is noted that claims 14 & 16 depends from claim 13, which incorporates the 103 rejection above with respect to at least claim 13. Thus, claims 14 & 16 are rejected separately from claims 2, 8-10, & 12, however incorporate the same obviousness rationale. Therefore, the Applicant is directed to the explanation of at least claims 2, 8, 9, & 12, regarding the sweepstakes mode. The combination of Emmerson & Acres as described in full detail above is applied hereto, thus, claims 14 & 16 are rejected for those same reasons. Regarding claim 16, as previously explained, Emmerson discloses downloading a plurality of games, where in view of Acres, at least some of the games having options to allow play of said games in a sweepstakes mode.

Claim 15: Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/MBS/